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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/791,326	03/02/2004	James J. Wang	22770	1809
<div>535 7590 07/11/2007</div> <div>K.F. ROSS P.C. 5683 RIVERDALE AVENUE SUITE 203 BOX 900 BRONX, NY 10471-0900</div>				
			EXAMINER HELM, CARALYNNE E	
			ART UNIT 1609	PAPER NUMBER
			MAIL DATE 07/11/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/791,326

Applicant(s)

WANG ET AL.

Examiner

Caralynne Helm

Art Unit

1609

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-26 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Election/Restrictions

Restriction

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-24 are drawn to a topical cosmetic composition, classified in class 424, subclass 401.
 - II. Claims 25-26, are drawn to a composition, classified in class 528, subclass 10.
2. Inventions I and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination (Group I) as claimed does not require the particulars of the subcombination as claimed because it could use an alternative hybrid silicone composite powder that would fall within the bounds of the claim language. Commercially available hybrid silicone composite powders exist such that the subcombination described in Group II is not necessary to create the combination described in Group I. The subcombination in Group II more generally describes a silicone resin composition. This subcombination has separate utility as a constituent of paint.
3. Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the inventions require a different field of search (see MPEP § 808.02), restriction for examination purposes as indicated is proper.

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4. The examiner has required restriction between combination and subcombination inventions. Where applicant elects a subcombination, and claims thereto are subsequently found allowable, any claim(s) depending from or otherwise requiring all the limitations of the allowable subcombination will be examined for patentability in accordance with 37 CFR 1.104. See MPEP § 821.04(a). Applicant is advised that if any claim presented in a continuation or divisional application is anticipated by, or includes all the limitations of, a claim that is allowable in the present application, such claim may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application. If the applicant elects Group I, then the election of species detailed below will also apply.

Election of Species

5. Claims 1-24 are generic to a plurality of disclosed patentably distinct species and describe the invention contained in Group I. The species are independent or distinct because as disclosed the different species have mutually exclusive characteristics for each identified species. In addition, these species are not obvious variants of each other based on the current record.

6. Applicant is required under 35 U.S.C. 121 to elect a disclosed species from each of the following 8 specie election requirements:

the volatile cosmetic fluid - a cyclomethicone, a low viscosity dimethicone fluid with viscosity ranging from 0.65 to 2 cSt, a C8-C12 hydrocarbon fluid, a low molecular weight alkylmethicone fluid or a mixture thereof;

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the organopolysiloxane fluid - dimethicone, phenyltrimethicone, alkyl dimethicone, silanol, amino-containing silicone, fluoroalkyl silicone, hydroxy-functional silicone, carboxy-functional silicone, alkoxy-functional silicone, high molecular weight silicone gum solution, silicone resin solution and silicone-grafted polyacrylate solution;

the oil base – mineral oils, plant oils, animal oils, fatty acids, fatty acid esters and fatty alcohols;

the gelling agent – mineral clays, metallic soaps, montmorillonite, polyglyceryl fatty acid esters, hydrophobic sucrose fatty esters, synthetic polymers, starch fatty acid ester and mixtures thereof;

the surface active agent - nonionic, anionic, cationic, amphoteric and oxyalkylene-modified organopolysiloxanes;

the cosmetic pigment - talc, kaolin, mica, pearl, magnesium carbonate, magnesium silicate, aluminum magnesium silicate, silica, calcium carbonate, zinc oxide, titanium dioxide, red iron oxide, yellow iron oxide, black iron oxide, ultramarine blue, polyethylene powder, polystyrene powder, silk powder, polymethacrylate powder, polytetrafluoroethylene powder, nylon powder, polyurethane powder, crystalline cellulose, titanated mica, bismuth oxychloride, interference pigments and mixtures thereof;

the preservative - phenoxyethanol, methylparaben, ethylparaben, propylparaben, butylparaben, isobutylparaben, imidazolidinyl urea, p-hydroxybenzoic acid, benzyl alcohol, disodium EDTA,

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sodium dehydroacetate, quaternary ammonium compounds, hydantoin derivatives and mixtures thereof;

and

the chemically effective active ingredient - sunscreen agents, tanning agents, vitamins, glycolic acid, salicylic acid, polyphenol, antimicrobial, botanical extracts, enzymes and lipids

for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable.

7. There is an examination and search burden for these patentably distinct species due to their mutually exclusive characteristics. The species require a different field of search (e.g., searching different classes/subclasses or electronic resources, or employing different search queries); and/or the prior art applicable to one species would not likely be applicable to another species; and/or the species are likely to raise different non-prior art issues under 35 U.S.C. 101 and/or 35 U.S.C. 112, first paragraph.

8. **Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species to be examined even though the requirement may be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected species**, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

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9. The election of the species may be made with or without traverse. To preserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the election of species requirement, the election shall be treated as an election without traverse. Traversal must be presented at the time of election in order to be considered timely. Failure to timely traverse the requirement will result in the loss of right to petition under 37 CFR 1.144. If claims are added after the election, applicant must indicate which of these claims are readable on the elected species.

10. Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the species unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other species.

11. Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Caralynne Helm whose telephone number is 571-270-3506. The examiner can normally be reached on Monday through Friday from 8am to 4pm (EDT).

13. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ardin Marschel, can be reached on 571-272-0718. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

14. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

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applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Ardin H. Marschel 6/30/07
ARDIN H. MARSCHEL
SUPERVISORY PATENT EXAMINER